

U.S. Patent Application No. 09/620,484
Attorney's Docket No. 99-317RCE1

REMARKS

This amendment is responsive to the Office Action dated December 7, 2004. Claims 1-2, 4-5, 7-8, 10-11, 13-20, 25 and 27-37 were presented for examination. Independent claims 1, 7, 13, 14, 17, 20, 25, 27, and 30 are all currently amended. Support for these amendments is found in the application as filed. For example, *see* at least Figs. 1 and 2, and the specification, at least at page 7, lines 19-21 for disclosure of user interface, and *see* at least Figs. 1 and 2 and at least page 7, lines 12-17 and page 12, lines 6-7 for disclosure of both local memory and storage of calling party number in local memory. No new matter is added by way of these amendments.

More specifically claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 25, and 27-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Patent Number 6,275,490 to Mattaway et al. (hereinafter "MATTAWAY") in view of Patent Number 6,078,582 to Curry et al. (hereinafter "CURRY"). Claims 14-20 are rejected under 35 U.S.C § 103(a) as being unpatentable over MATTAWAY in view of CURRY in further view of Wiener et al., U.S. Patent Number 6,324,264 (hereinafter WIENER). Applicant respectfully traverses the rejection of these claims for the following reasons.

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 25, and 27-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over MATTAWAY in view CURRY. These claims are not disclosed or suggested by this combination of references. For example, consider amended independent claim 1 which recites a combination of features.

A method of making a telephone call using a computer having a user interface, the computer operating upon an electronic document, comprising: receiving an

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electronic document that includes data representing at least one telephone number; selecting by way of the user interface a telephone number from a location in the electronic document to obtain a selected telephone number; retrieving data, associated with the location, from the electronic document, wherein the data comprises the telephone number in a format usable for setting up a call; receiving a calling party telephone number; storing the calling party telephone number in local memory within the computer to obtain a locally stored calling party telephone number; signaling, via a packet-switched network, a telecommunication system to connect a call between the selected telephone number and the calling party telephone number using the retrieved data; and using the locally stored calling party telephone number to connect all calls from the calling party, subsequent to attempting the call, to any telephone number including the selected telephone number. (Emphasis added.)

The Office Action, page 3, states deficiencies in MATTAWAY with respect to claim 1, namely:

"Mattaway does not expressly disclose receiving a calling party telephone number; storing the calling party telephone number in memory within the computer to obtain a stored calling party telephone number; and using the stored calling party telephone number to connect all calls from the calling party, subsequent to attempting the call, to any telephone number including the selected telephone number." Applicant agrees.

The Examiner relies on CURRY to make up for these deficiencies of MATTAWAY, but CURRY falls short. Applicant respectfully disagrees that CURRY teaches storing the calling party telephone number in memory within the computer to obtain a stored calling party number as alleged in the Office Action, because amended claim 1 limits its computer to one "having a user interface". By contrast, the computer upon which the Examiner is relying in this rejection does not and cannot have a user interface, because "users" cannot be associated with it. The computer in CURRY upon which the Office Action relies to store the calling party number in this rejection is the Internet Telephony Server(s) (ITS 72 a, b, c) as shown in Fig. 6 in CURRY. For example, the language: "...where, when the ITS, acts like a phone, it uses its stored calling

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party number in order to set-up a call..." (Office Action, page 3, Emphasis added) plainly shows that the ITS server in CURRY is being relied upon to teach the storing of the calling party number. But, this server is shown as remotely located on the opposite side of telco central office 41 from where the user (calling/called parties 64 a, b, c) is physically located. Thus, (1) the ITS 72 server is not local memory and (2) there are no users located at ITS 72 thereby precluding a user interface at ITS 72. Therefore, although CURRY may store something in a remote server (a server is a computer), it does not disclose or suggest: "storing the calling party telephone number in local memory within the computer to obtain a locally stored calling party telephone number", as recited in claim 1 (Emphasis added) and exemplified by Applicant's RAM 220 and ROM 225 local memory contained within its user-interfaced computer 105.

As noted, the Examiner admitted that MATTAWAY does not disclose this claim element in claim 1, and Applicant has shown above that CURRY does not disclose this claim element in claim 1. Therefore, all claim elements of claim 1 have not been disclosed or suggested by this combination of references.

To establish a *prima facie* case of obviousness, all of three basic criteria must be met: first, the prior art references, when combined, must teach or suggest *all* the claim limitations; second there must be a reasonable expectation of success; and finally, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings (*See* MPEP § 2143). If any one of these criteria is not met the *prima facie* case of

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obviousness is not established. In this instance, the prior art references, when combined, do not teach or suggest all of the claim limitations.

In view of the above, a prima facie case of obviousness under MPEP § 2143 has not been established against claim 1, at least because all of the claim elements of claim 1 have not been disclosed or suggested. For example, at least the recited "storing" act has not been disclosed or suggested. That is, the recited "storing the calling party telephone number in local memory within the computer to obtain a locally stored calling party telephone number" is not disclosed or suggested by MATTAWAY or CURRY taken alone or in any combination for the reasons given above. The cited computer in CURRY is not, and cannot be, Applicant's recited/defined computer.

Furthermore, although WIENER was not cited against these claims, it is noted for the sake of completeness that WIENER does not cure the above-noted deficiencies of MATTAWAY and CURRY used in the rejection of these claims. WIENER shows a directory service 14 in its Fig. 1 in which telephone numbers may be stored and accessed by its interactive device 16 by way of Internet 12. Obviously, any such storage of telephone numbers is not the claimed local storage: "storing the calling party telephone number in local memory within the computer to obtain a locally stored calling party number", (Emphasis added), as recited in claim 1. This amendment is supported at least by Applicant's Fig. 2 showing local RAM and ROM memory within computer 105 in which the calling party telephone number may be stored as discussed in Applicant's specification, for example, on page 12, lines 6-7 as noted above.

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The other two requirements for establishing a *prima facie* case of obviousness are moot, and shall not be considered in view of the failure of the references to show all claim elements. It is therefore submitted that the 35 U.S.C. § 103(a) rejection of claim 1 should be withdrawn and the claim allowed.

Independent claims 7, 13, 25, 27, and 30, also rejected over MATTAWAY in view of CURRY, have been similarly amended. Therefore, it is submitted that these claims are allowable for reasons similar to those given above.

Each one of dependent claims 2, 4, 5, 8, 10, 11, 15, 16, 18, 19, 28, 29, and 31-37 is dependent, directly or indirectly, from one of these allowable independent claims, and is therefore submitted to be allowable for reasons based on, at least, its respective dependency from an allowable base claim.

Claims 14-20 are rejected under 35 U.S.C § 103(a) as being unpatentable over MATTAWAY in view of CURRY in further view of WIENER. As noted above, WIENER does not cure the various above-noted deficiencies in MATTAWAY or CURRY. As discussed above, the calling party's telephone number is stored in WIENER in a remotely located database accessible through the Internet and not locally, in a computer having a user interface (e.g., a personal computer). Thus, "storing the calling party telephone number in local memory within the computer to obtain a locally stored calling party telephone number", as recited in claim 1, is not disclosed or suggested by WIENER, because WIENER stores the calling party telephone number remotely from the user in a database that doesn't have a user interface. Applicant shows computer 105 with computer terminal screen user interface in its Fig. 1 and shows computer 105

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as containing input device 210 in its Fig. 2. Input device 210 is described in Applicant's specification on page 7, lines 19-20 as containing one or more user interfaces. In the computer shown in Applicant's Fig. 2, ROM 225 is the location (the local memory within the computer having a user interface) in which the calling party's phone number may be stored. See Applicant's specification, page 12, lines 6-7, for example. Applicant submits that WIENER's remote directory, accessible only via an Internet link and which stores the calling party's telephone number, by contrast, is not equivalent to a computer having a user interface which locally stores the calling party's telephone number. Applicant thus submits that WIENER teaches away from Applicant's subject matter as recited in the currently amended claims and does not cure this deficiency of MATTAWAY or CURRY. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection of these claims be withdrawn and the claims allowed for the reasons given above.

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In view of the foregoing amendments and remarks, all pending claims are urged to be allowable over the cited references. Applicant respectfully requests the Examiner's reconsideration of this application, and the timely allowance of the pending claims. If any questions remain, the Examiner is invited to contact the undersigned at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2347 and please credit any excess fees to such deposit account.

Respectfully submitted,

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